



UNITED STATES PATENT AND TRADEMARK OFFICE

CIC
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,529	01/27/2004	Takayuki Inoue	248223US0	9555

22850 7590 09/29/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,529

Applicant(s)

INOUE ET AL.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-15, 17-23 and 1-7, 16 in part is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2. | 6) <input type="checkbox"/> Other: _____ |

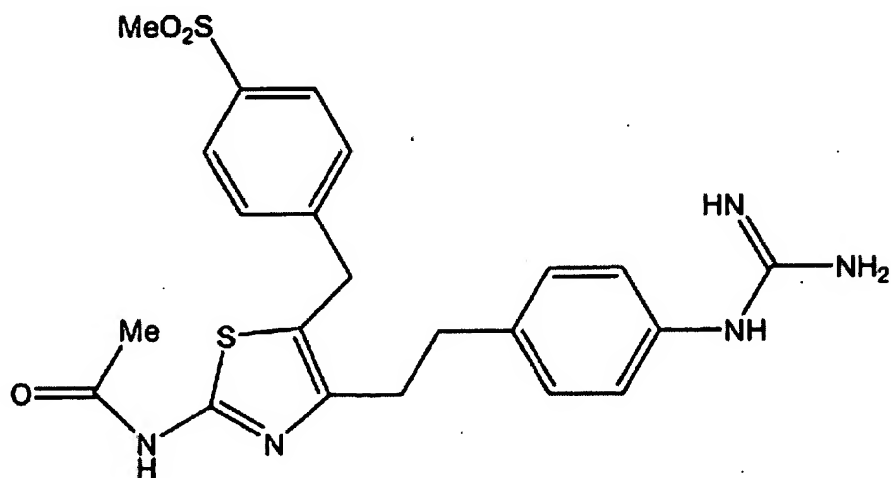
Art Unit: 1626

Claims 1-23 are pending in this application.

Claims 8-15, 17-23 and 1-7, 16 in part, are drawn to non-elected invention.

RESTRICTION REQUIREMENT

In response to the Restriction Requirement, Applicant elects with traverse the invention of group XXXIV, claims 1-7, 16 in part. The traversal is on the basis that the Office has not shown it would be undue burden to examine all the groups. This is not persuasive for reasons set forth in the Restriction Requirement. In fact it would be undue burden to do so. Applicant also elects the following species:



Therefore, claims 1-7, 16 are being examined in part subject to the election made by applicant.

Status of Claims

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall

Art Unit: 1626

into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

The elected compound above is found in condition for allowance. In accordance with Markush practice, the Office would like to consider additional species for examination but for two reasons. The compounds within the elected group XXXIV were not identified and the corresponding substituents in formula I are not identified in the elected species. Therefore, if Applicant desires for the Office to examine additional species, such must be identified and a generic structure embracing all the species must be presented for examination. All the species together must share "a substantial structural feature" and a utility relating to the structural feature must be identified in the specification. Applicant should note the requirement of Markush practice under MPEP 803.02 is "a" substantial structural feature not "structural features". Therefore, all variables in the generic structure would not count as been shared by all the compounds.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-7, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1626

Claim 1 as written is not clear and confusing. It is not possible to search formula (I) in the claim. Therefore, claims 1-7, 16 are indefinite. By writing claim 1 in proper Markush format the rejection would be overcome.

Claims 6 and 16 improperly depend from claim 1 for failure to limit the scope of claim 1. Claims 1, 6, and 16 are drawn to the same compounds. Claims 6 and 16 recite intended use of the compounds. However, intended use is not a limitation of a compound or product. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). By deleting claims 6 and 16 the rejection would be overcome.

Allowable Subject Matter

Claims 1-7, 16 are objected to for containing non-elected subject matter. To place the application in condition for allowance, all claims drawn to non-elected subject matter must be cancelled and the remaining claims must be amended within the scope of allowable subject matter set forth above under Status of Claims.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Art Unit: 1626

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Taofiq Solola', written over a horizontal line.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1626

September 27, 2005